

Attorney Docket: Beiersdorf 617.1
USSN 09/581,412

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

REMARKS

Claims 11-40 are pending in the application. Claims 11,19-20,23, and 38-39 are amended and claims 18 and 37 have been canceled.

The claims have been rejected as obvious over Aronson in view of Jackman and Schneider. In response, Applicants have amended claim 11 to require that the partially neutralized mono/diglyceride esters and the sorbitan monoesters are in a fixed weight ratio. Clear support for fixing the weight ratios of these components can be found in the specification – e.g., page 8; and original claim 9.

Therefore, the amendment does not add new matter.

A. Monoglyceride Esters Cannot Be Presumed To Be Similar To Esters Of Monoglycerides And/Or Diglycerides Of Saturated Fatty Acids That Are Partially Neutralized With Citric Acid

In a previous office action, Paper 18, mailed on 12 March 2003, Examiner stated that Jackman teaches o/w emulsions wherein the ratio of monoglyceride ester to sorbitan stearate is 3:2; see Exs. 1-2. However Applicants respectfully disagree with Examiner's apparent conclusion that Jackman's disclosure renders former claim 18, and the newly amended claims, obvious. See page 4, Paper 18.

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The claimed compositions specifically require esters of monoglycerides and/or diglycerides of saturated fatty acids that are also partially neutralized with citric acid. These compounds are not equivalents of glycerine monoesters, nor are they similar enough to presume so. If they were equivalent in their afforded properties then the Schneider reference would not be required to establish the instant rejection.

However, Schneider is required in this rejection because the prior art disclosure of glycerine monoesters is not sufficient to maintain the rejection over the instant claimed composition comprising monoglycerides and/or diglycerides of saturated fatty acids preclude them from being treated as equivalents. Specifically, these two groups of compounds do not fall within similar homologous series. Therefore, monoglyceride esters cannot properly be presumed to possess similar properties to those of the partially neutralized mono/diglyceride esters. MPEP § 2144.09 (Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977) (Emphasis added).

To the extent that Examiner has presumed that the two classes of glyceryl esters in question are freely interchangeable, any rejection of the amended claims based on Jackman's teaching described above, would be improper. In other words, a weight ratio of glycerine monoesters to sorbitan esters is not *prima facie* obvious over a range of weight ratios of partially neutralized mono/diglyceride esters to sorbitan esters.

On this basis, it is requested that the rejection of the amended claims under § 103 be withdrawn.

B. The Weight Ratios Of The Partially Neutralized Esters Of Monoglycerides And/Or Diglycerides And The Sorbitan Esters Are Not Routinely Optimized Variables

On page 5 of the office action, Paper 18, Examiner states that because she believes that Jackman teaches the general conditions of the claims, that various concentration-

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related parameters recited in the claims are merely routinely optimized variables. MPEP § 2144.05; (A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977))(Emphasis added).

However, neither of the references alone or in combination, teach that the weight ratio of the partially neutralized esters of monoglycerides and/or diglycerides and the sorbitan esters are significant in any way. Nor do the references disclose that this ratio may be varied within a specific range of weight ratios. Thus, this parameter does not qualify as a result-effective variable under PTO guidelines.

In accordance, the newly amended claims are not obvious over the combined references, because the combination of references does not teach this claim limitation. Even Schneider, the only reference that actually discloses the use of the partially neutralized esters of monoglycerides and/or diglycerides, only discloses in one example, Ex. 10, a ratio of 1:1.


Further, there is no additional disclosure in the specification as to the importance of this ratio. Therefore, this parameter is not taught or suggested in the references as being a result effective variable and does not satisfy the rule in *Antonie*. Therefore, the addition of this limitation to the amended claims is not merely routine optimization.

In sum, the amended claims are patentably distinct over the combined disclosures of Aronson, Jackman and Schneider. Therefore, Applicants respectfully request that the claims be allowed in view of the foregoing comments and the amendments below.

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